REMARKS

Claim 12 is objected to for an informality of using an acronym for the first time without spelling out the full name from which the acronym is derived. This objection is overcome in view of the amendment to claim 12.

Claims 1-11, 15-28 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kouzu et al (US 6,211,645 B1) (hereinafter Kouzu) in view of Osaka (US 5,628,054) (hereinafter Osaka). Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kouzu in view of Osaka and in further view of Townsley et al (US 5,532,524). Claims 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kouzu and in view of Townsley and in further view of Osaka. These rejections are not applicable to the claims as amended.

Each independent claim 1, 15, 29 and 38 include: the first and second subassemblies being packaged separately during shipping in a manner satisfying a regulatory threshold sufficient to avoid increased shipping costs applied when the subassemblies are shipped connected, the regulatory threshold including a battery characteristic such as one of a watt hour rating of the battery and a weight of a chemical element of the battery.

The independent claims and their respective dependent claims are submitted to be allowable.

As the PTO recognizes in MPEP §2142:

> The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the first and second subassemblies being packaged separately during shipping in a manner satisfying a regulatory threshold sufficient to avoid increased shipping costs applied when the subassemblies are shipped connected, the regulatory threshold including a battery characteristic such as one of a watt hour rating of the battery and a weight of a chemical element of the battery.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

> [T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests the first and second subassemblies being packaged separately during shipping in a manner satisfying a regulatory threshold sufficient to avoid increased shipping costs applied when the subassemblies are shipped connected, the regulatory threshold including a battery characteristic such as one of a watt hour rating of the battery and a weight of a chemical element of the battery.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1-38 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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